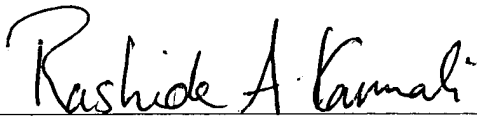


Doc Code: AP.PRE.REQ

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PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional) 144.002	
I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR on <u>12/12/2005</u> Signature _____ Typed or printed name <u>Rashida A. Karmali</u>	Application Number 09/932,004		Filed August 17, 2001
	First Named Inventor Michael Neece et al		
	Art Unit 2177	Examiner Luke S. Wassum	
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p> <div><div><p>I am the</p><p><input type="checkbox"/> applicant/inventor.</p><p><input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)</p><p><input checked="" type="checkbox"/> attorney or agent of record. Registration number <u>43,705</u></p><p><input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____</p></div><div><p> Signature <u>Rashida A. Karmali</u> Typed or printed name <u>212-651-9653</u> Telephone number <u>12/12/2005</u> Date</p></div></div> <p>NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.</p>			

<input checked="" type="checkbox"/> *Total of <u>3</u> forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.



Customer No 42131

Docket No. 144.002

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Michael Neece et al

Serial No.: 09/932,004

Art Unit: 2177

Filed: August 17, 2001

Examiner: WASSUM, Luke S.

For: Systems and Methods For Intelligent Hiring

Commissioner for Patents
P.O. Box 1450, Alexandria,
VA 22313-1450(Mail Stop AF)

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Sir:

In response to the Final Office Action dated August 17, 2005 Applicant files this Pre-Appeal Brief, requesting a review of the Final Action issued. Applicants have filed herewith a Notice of Appeal, and a Petition for Extension of Time to file the Notice of Appeal with appropriate fees. Applicants include herewith the following documents:

1. Office Action mailed 2/24/2005 - Exhibit 1
2. Amendment filed 6/22/2005 - Exhibit 2
3. Final Action mailed 8/17/2005 -Exhibit 3

REMARKS

Claims 1, and 3 to 11 are under consideration. Reconsideration of all claims is respectfully requested.

In paragraph #8. The Action states “Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).”

In response, applicants submit that Michael Neece, Christopher Faust, and Todd Becker, the inventors listed in the record are true inventors of each claim in the application and submit that the subject matter of the various claims was commonly owned at the time of the invention under section 103 (c) and potential 35 U.S.C. 102(e), (f) or (g).

35 U.S.C. § 103 (a)

Paragraph 9 is reproduced below. Paragraphs 10-19 are duplicates of Paragraphs 21 through 30 of the Office Action dated 2/24/2005. See Exhibits 1 and 3

9. Claims 1 and 3-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stimac (U.S. Patent Application Publication 2003/0071852) in view of Taylor (U.S. Patent 5,832,497).

Citing Office Action dated 2/24/2005, on Pages 17 and 18, the Action cites MPEP

2143.01 [R-2] to provide authority and states

“Three possible sources for a motivation to combine references: the nature of the problem to be solved, the teachings of the prior art and the knowledge of the persons of ordinary skill in the art. In re Rouffet, 149 F. 3d 1350, 1357, 47 USPQ 2d 1453, 1457-58 (Fed. Cir. 1998)(The combination of the references taught every element of the claimed invention, however, without a motivation to combine, a rejection based on a prima facie case of obvious was held improper). The level of skill in the art cannot be relied upon to provide the suggestion to combine references. Al-Site Corp. v. VSI Int’l Inc., 174 F 3d 1308, 50 USPQ 2d 1161 (Fed. Cir. 1999).

“ In determining the propriety of the Patent Office case for obviousness in the first instance, it is necessary to ascertain whether or not the reference teachings would appear to be sufficient for one of ordinary skill in the relevant art having the reference before him to make the proposed substitution, combination, or other modification.” In re Linter, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972)....

In Ruiz v. A.B. Chance Co., 357 F3d 1270, 69 USPQ 2d 1686 (Fed. Cir. 2004, the patent claimed underpinning a slumping building foundation using a screw anchor attached to the foundation by a metal bracket. One prior art reference taught a screw anchor with a concrete bracket, and a second prior art reference disclosed a pier anchor with a metal bracket. The court found motivation to combine the references to arrive at the claimed invention in the “nature of the problem to be solved” because each reference was directed “to precisely the same problem to be solved” because each reference was directed “to precisely the same problem of underpinning slumping foundations.” Id at 1276, 69 USPQ2d at 1690. The court also rejected the notion that “an express written motivation to combine must appear in prior art references...” Id at 1276, 69 USPQ at 1690.,

In response, applicant filed and Amendment on June 22, 2005 (Exhibit 3) and argued and argued that by applying the above case law, the nature of the problem to be solved in the present invention and in the cited references is clearly NOT the same. The motivation to control costs and facilitating accounting management (of the present invention) is not present in Taylor. Therefore, pursuant to In re Rouffet, the above rejection was improper.

Applicants also amended Claims 1, 7, 10 and 11 to include the limitation of the accounting system “facilitating the accounts management”, and argued that as a matter of law, the above rejection cannot be sustained.

In the Final Action, in Paragraph 23, the examiner states “Regarding the Applicants argument that there is no motivation to combine the Taylor reference with the Stimac reference, the examiner disagrees.” The Action then states that

“ At col. 6, lines 47-57, Taylor teaches that an accounting system can be used to impose charges on the users of the system. Particularly in light of the fact that the Stimac reference teaches the use of their system by job recruiting/placement firms (e.g., paragraphs [0005], [0006], 0137], et seq.), an ordinary artisan would find it

obvious to incorporate an accounting system in order to impose charges on users of the system.

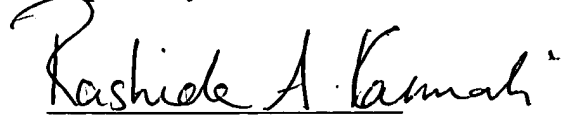
Given this fact the examiner then points out that the motivation as stated in the rejection of record has been found in the prior art, and not in the nature of the problem to be solved (as argued by the applicants)”

In response, applicants submit that the examiner’s conclusion is NOT supported by Ruiz v. A. B. Chance Co, 357 F 3d 1270, 69 USPQ 1686 (Fed. Cir. 2004), cited by the Examiner in the Office Action of 2/24/2005. See above discussion. In Ruiz, the Federal Circuit found motivation to combine one reference that described the screw anchor with a concrete bracket, with a second reference that described a pier anchor with a metal bracket, to arrive at the claimed invention in the “nature of the problem to be solved” because each reference was directed .”to precisely the same problem of underpinning slumping foundations.” Id. At 1276, 69 USPQ2d at 1690.

The examiner has turned his own argument based on Ruiz, upon its head. Furthermore, in Ruiz, the Federal Circuit specifically explained that a court or an examiner may find motivation to combine prior art references in the nature of the problem solved, particularly in cases of “simpler mechanical technologies”. The Federal Circuit warned that for technologically complex inventions section 103 required that in making the assessment of differences, the claimed invention be considered “as a whole”. The examine has not provided any legal authority for his decision to combine Stimac and Taylor and the citations he has provided above: 1) col. 6, lines 47-57, Taylor, and 2) paragraphs [0005], [0006], 0137], et seq., Stimac are related to “nature of the problem to be solved” under Ruiz, even if the examiner states otherwise.

In summary, the rejection of claims 1, and 3-11 pursuant to 35 U.S.S 103 cannot be sustained based as a matter of law and fact. This rejection should be withdrawn.

Respectfully Submitted,



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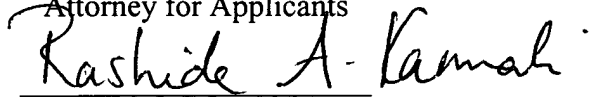
Date: December 12, 2005

CERTIFICATE OF EXPRESS MAILING

I hereby certify that this correspondence is transmitted by Express Class No. EQ 063058877 US under 37 C.F.R. 1.10 on December 12, 2005 addressed to: Commissioner for Patents, Alexandria, VA 22313-1450.

Rashida A. Karmali

Attorney for Applicants



Signature

12/12/05



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/932,004	08/17/2001	Michael Neece	144.002	4173

7590 02/24/2005
Rashida A. Karmali, PhD
99 Wall Street
13th Floor
New York, NY 10005



EXAMINER

WASSUM, LUKE S

ART UNIT PAPER NUMBER

2167

DATE MAILED: 02/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Exh 1

Office Action Summary

DEC 12 2005

Application No.

09/932,004

Applicant(s)

NEECE ET AL.

Examiner

Luke S. Wassum

Art Unit

2167

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 January 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 3-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 August 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- 1. ☐ Certified copies of the priority documents have been received.
 - 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 18 January 2005 has been entered.

The Invention

2. The claimed invention is a system for facilitating the hiring process, including searchable databases for job openings and positions.

Response to Preliminary Amendment

3. The Applicants' preliminary amendment, filed 18 January 2005, has been received, entered into the record, and considered.
4. As a result of the amendment, claims 1, 4, 7 and 10-12 have been amended, and claim 2 has been canceled. Claims 1 and 3-12 are pending in the application.

Claim Objections

5. Claim 10 is objected to because of the following informalities:

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In the last limitation, 'said data management system' should be 'said *database* management system'. Appropriate correction is required.

6. In view of the amendment to claim 12, the examiner withdraws the objection to this claim.

Claim Rejections - 35 USC § 112

7. In view of the amendment to claim 1, the examiner withdraws the claim rejection to claim 1 (and dependent 3-9) under 35 U.S.C. § 112.

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claims 4, 6, 7, 9, 10 and 12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

10. Regarding claim 4, the limitation that the group consisting of a selection criteria, data on coordination of interviews, data on preparation of questions, data on feedback from interviews and data on candidate evaluations is characterized as key fields renders the claim indefinite.

In the database art, a key field is a field containing a specific single attribute of a record. None of the claimed group conforms to the requirement that they be a single attribute. See also

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examiner's remarks concerning the meaning of 'key field' in the database art from the final rejection mailed 18 October 2004.

The examiner has included the definitions definitions of the terms 'field' and 'key field' from the Microsoft Computer dictionary for the Applicants' convenience.

11. Claims 6, 7 and 9, incorporating the deficiencies of parent claim 4, are likewise rejected.

12. Claim 7 recites the limitation "said means for searching key fields" in line 1. There is insufficient antecedent basis for this limitation in the claim.

The examiner notes the Applicants' amendment of claim 7 to address this rejection; however, the antecedent 'said means for searching key fields' does not appear in claim 4, *but does appear in claim 6*.

13. Claim 9 recites the limitation "said means for searching key fields" in line 3. There is insufficient antecedent basis for this limitation in the claim.

14. Claim 10 recites the limitation "said data management system" in the last limitation. There is insufficient antecedent basis for this limitation in the claim.

15. Claim 12 recites the limitation "the information compiled on hiring practices" in line 3. There is insufficient antecedent basis for this limitation in the claim.

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16. Further regarding claim 12, the claim is rendered indefinite, because "updating information on hiring practices" is inconsistent with the 'comprising' clause of "defining a position, coordinating the interview teams, organizing the interview questions, evaluating the candidates, reviewing the candidate evaluations and making customized hiring choices".

The examiner notes the Applicants' amendment to address this rejection. However, for example, the step of updating information on hiring practice cannot comprise such steps as defining a position, because a position is not information on hiring practice. Furthermore, none of the other claimed steps equate to updating information on hiring practice.

While the Applicants are certainly free to claim the steps cited in claim 12 as limitations, the characterization of these steps as 'updating information on hiring practice' renders the claim indefinite, because the information being updated concerns the act of hiring specific applicants, not updating information on hiring practice.

The examiner interprets the limitation 'information on hiring practice' as information relating to the policies and procedures used in the process of hiring individuals. For example, defining a position would have no bearing on the policies and procedures used in the process of hiring individuals, but is in fact a part of the process of hiring an applicant for a specific job opening.

Claim Rejections - 35 USC § 103

17. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary

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skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

18. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

19. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

20. Claims 1 and 3-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Stimac** (U.S. Patent Application Publication 2003/0071852) in view of **Taylor** (U.S. Patent 5,832,497).

21. Regarding claim 1, **Stimac** teaches a computer readable medium of instructions configured as a multiple database information exchange and hiring system used in network operations substantially as claimed, said system comprising:

- a) a first database of information pertaining to a job opening or demand-side needs of a company, stored in electronically readable memory (see disclosure of the additional information, such as position contact information and location, that constitutes the claimed job opening, paragraphs [0128] through [0130]; see also Figure 30A);
- b) a second database of information on positions, interview teams, questions to evaluate candidates by skills, experience or personal profiles related to the job opening (see disclosure of positions information at paragraphs [0127] and [0128] and in Figure 30A; see also disclosure of information on interview teams, paragraphs [0157] and [0158] and also Figures 62, 63 and 64; see also disclosure of information on questions to evaluate candidates, paragraph [0159] and Figures 65, 66 and 66A);
- c) a server and communication port suitable for transmitting and receiving data from the first database, instructions from the second database or coordinating the communication between interviewers in the form of electrical signals to and from remote computers (see disclosure that the system allows information to be electronically shared and portions of the recruitment process to be handled by different recruiters throughout the world, paragraphs [0009] through [0011]);
- d) a database management system for creating and revising records of said first database and said second database connected to said electrically readable memory responsive to the remote computers (see paragraphs [0128] through [0130]);
- e) an interactive database query engine connected to said memory, said query engine configured to permit a plurality of searches and appended searches by a plurality of users, including position owner, position contributor or an interviewer to produce current results that are coordinated and communicated between all users (see

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paragraphs [0126] and [0127], and also Figure 29; see also disclosure that various information can be shared globally, paragraphs [0009] through [0011]); and

- f) a process controller connected to said interactive database query engine, said process controller facilitating an intelligent, collaborative and coordinated solution to demand-side job recruiting, wherein said interactive database query engine is a company database containing human resource and hiring records (see disclosure of a method and system for managing the recruitment process and including a database of human resource information, paragraphs [0103] through [0108]).

Stimac does not explicitly teach a computer readable medium further comprising an accounting system connected to said process controller.

Taylor, however, teaches an accounting system connected to said process controller (see col. 2, line 13; see also col. 6, lines 47-57).

It would have been obvious to one of ordinary skill in the art at the time of the invention to include an accounting system, since this would allow the operator of the system to charge a fee for its use (see col. 6, lines 47-57).

22. Regarding claim 10, Stimac teaches a computer software system provided to execute hiring practices intelligently substantially as claimed, said system comprising:

- a) a first database of information pertaining to job openings and demand-side needs of a company (see disclosure of the additional information, such as position contact information and location, that constitutes the claimed job opening, paragraphs [0128] through [0130]; see also Figure 30A);
- b) a second database of positions information, interview teams and questions to evaluate candidates by skills, experience and personal profiles (see disclosure of positions information at paragraphs [0127] and [0128] and in Figure 30A; see also disclosure of information on interview teams, paragraphs [0157] and [0158] and also Figures 62, 63 and 64; see also disclosure of information on questions to evaluate candidates, paragraph [0159] and Figures 65, 66 and 66A);
- c) a third database of company records compiled by the human resources department, said third database containing user data records, administration data records, option data records, search data records or tutorial data records (see disclosure of a method and system for managing the recruitment process and including a database of human resource information, paragraphs [0103] through [0108]);
- d) a database management system connected to the software linking it to multiple databases and multiple remote controllers (the claimed database management system being inherent in a system having the wide range and types of data of that taught in the reference; see disclosure that the system can be used to share data worldwide, thus requiring multiple remote controllers, paragraphs [0009] through [0011]);
- e) an interactive database query engine connected to said database management system configured to permit a plurality of searches and appended searches by a plurality of users, including position owner, position contributor or an interviewer to produce

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current results that are coordinated and communicated between all users (see paragraphs [0126] and [0127], and also Figure 29; see also disclosure that various information can be shared globally, paragraphs [0009] through [0011]); and
f) a process controller connected to said database management system to facilitate collaborative and coordinated solution to demand-side process of recruiting (see disclosure of a method and system for managing the recruitment process and including a database of human resource information, paragraphs [0103] through [0108]).

Stimac does not explicitly teach a computer readable medium further comprising an accounting system connected to said process controller.

Taylor, however, teaches an accounting system connected to said process controller (see col. 2, line 13; see also col. 6, lines 47-57).

It would have been obvious to one of ordinary skill in the art at the time of the invention to include an accounting system, since this would allow the operator of the system to charge a fee for its use (see col. 6, lines 47-57).

23. Regarding claim 11, **Stimac** teaches a method of hiring personnel intelligently substantially as claimed, said method comprising the steps of:

- a) creating a computer readable file including information pertaining to job openings and needs of a company (see disclosure of the additional information, such as position contact information and location, that constitutes the claimed job opening, paragraphs [0128] through [0130]; see also Figure 30A);
- b) uploading a portion of the computer readable file to a medium accessible via a computer network with information on interview teams, questions to evaluate candidates by skill, experience and personal profiles and instructions for interviewers (see disclosure that the system can be used to share data worldwide, paragraphs [0009] through [0011], and that the preferred mechanism for data sharing is the Internet, paragraph [0100]; see also disclosure of positions information at paragraphs [0127] and [0128] and in Figure 30A; see also disclosure of information on interview teams, paragraphs [0157] and [0158] and also Figures 62, 63 and 64; see also disclosure of information on questions to evaluate candidates, paragraph [0159] and Figures 65, 66 and 66A; see disclosure of instructions for interviewers, paragraph [0159] and Figure 67);
- c) searching information in the uploaded portion of the computer readable file for the presence of information corresponding to information requested by a user (see disclosure of different search/retrieval functionality available, paragraphs [0126] and [0138]);
- d) accessing the information requested from relevant database in the network (see disclosure of different search/retrieval functionality available, paragraphs [0126] and [0138]);
- e) assigning tasks, coordinating interview processes and managing interview evaluations from teams (see disclosure of the assigning tasks and coordinating the interview process,

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paragraphs [0157] through [0159] and Figures 62, 63 and 64; see also managing interview evaluations, paragraph [0160] and Figures 68 and 69); and

- f) permitting the user to send said information via the computer network to another computer readable file located in the same hiring environment, to exchange said information with another user and to facilitate creating a coordinated summary of recommendations for hiring (see disclosure that the system can be used to share data worldwide, paragraphs [0009] through [0011]).

Stimac does not explicitly teach a computer readable medium further comprising an accounting system connected to said process controller.

Taylor, however, teaches an accounting system connected to said process controller (see col. 2, line 13; see also col. 6, lines 47-57).

It would have been obvious to one of ordinary skill in the art at the time of the invention to include an accounting system, since this would allow the operator of the system to charge a fee for its use (see col. 6, lines 47-57).

24. Regarding claim 3, **Stimac** additionally teaches a computer readable medium further comprising a security means connected to said process controller (see userid/password access control, paragraph [0101]).

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25. Regarding claim 4, **Stimac** additionally teaches a computer readable medium wherein the human resources records contain a plurality of search key fields, each of said key fields consisting of a search criteria, data on coordination of interviews, data on preparation of questions, data on feedback from interviewers or data on candidate evaluations (see paragraphs [[0109] through [0111], [0128] through [0135]; see also Figures 62, 63, 64, 68 and 69).

26. Regarding claim 5, **Stimac** additionally teaches a computer readable medium further comprising a database of instructions pertaining to training of users (see disclosure of interview tips which provides a helpful guide to interviewing, paragraph [0159] and Figure 67).

27. Regarding claim 6, **Stimac** additionally teaches a computer readable medium wherein said interactive database query engine includes means for searching key fields of a database for the satisfaction of one or more conditions, and means for reporting and exchanging all variables in said search key fields of records which satisfy said one or more conditions (see disclosure of different search/retrieval functionality available, paragraphs [0126] and [0138]; see also disclosure that the system can be used to share data worldwide, paragraphs [0009] through [0011]).

28. Regarding claim 7, **Stimac** additionally teaches a computer readable medium wherein said means for searching key fields of a database include at least one of a customer administration key, an interview key, a report key, an options key, a search key or a tutorial key (see administration screen in paragraph [0102], and interview in paragraphs [0113] and [0131] through [0134]).

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29. Regarding claim 8, **Stimac** additionally teaches a computer readable medium further comprising means for organizing the hiring process by coordinating the exchange of information at every step of the hiring process between different levels of users assigned for the hiring process (see disclosure that the system can be used to share data worldwide, paragraphs [0009] through [0011]), wherein the hiring process includes the steps of defining a position (see disclosure of the additional information, such as position contact information and location, that constitutes the claimed job opening, paragraphs [0128] through [0130]; see also Figure 30A), coordinating the interview teams (see disclosure of the assigning tasks and coordinating the interview process, paragraphs [0157] through [0159] and Figures 62, 63 and 64), organizing the interview questions (see disclosure of information on questions to evaluate candidates, paragraph [0159] and Figures 65, 66 and 66A; see also paragraph [0161] and Figure 71), evaluating the candidates (see managing interview evaluations, paragraph [0160] and Figures 68 and 69), and reviewing the candidate evaluations (see managing interview evaluations, paragraph [0160] and Figures 68 and 69).

30. Regarding claim 9, **Stimac** additionally teaches a computer readable medium further comprising means to restrict entries in at least one of said means of searching key fields of a database to a predetermined set of entries (see disclosure of the use of drop-down menus, effectively restricting entries in the search key fields, paragraphs [0103], [0109], [0117], [0128], [0129] and [0161]).

31. Regarding claim 12, **Stimac** additionally teaches a method of hiring personnel intelligently, further comprising the step of updating routinely the information compiled on hiring practices within a hiring environment (see updating, paragraphs [0108], [0127] and [0143]), said steps

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comprising defining a position (see disclosure of the additional information, such as position contact information and location, that constitutes the claimed job opening, paragraphs [0128] through [0130]; see also Figure 30A), coordinating the interview teams (see disclosure of the assigning tasks and coordinating the interview process, paragraphs [0157] through [0159] and Figures 62, 63 and 64), organizing the interview questions (see disclosure of information on questions to evaluate candidates, paragraph [0159] and Figures 65, 66 and 66A; see also paragraph [0161] and Figure 71), evaluating the candidates (see managing interview evaluations, paragraph [0160] and Figures 68 and 69), and reviewing the candidate evaluations (see managing interview evaluations, paragraph [0160] and Figures 68 and 69).

Response to Arguments

32. Applicant's arguments filed 18 January 2005 have been fully considered but they are not persuasive.

33. In response to the Applicants' arguments concerning the rejections under 35 U.S.C. § 112, these arguments are responded to above.

34. In response to the Applicants' argument that the *Stimac* reference does not take into account the accounting component, this reference is not relied upon to address the accounting component; this limitation is addressed by the *Taylor* reference. Thus, this argument is moot.

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35. In response to the Applicants' argument that the **Stimac** reference fails to make interviewing an essential element of the invention, the examiner has properly mapped the claimed limitations to the capabilities as taught in the **Stimac** reference. In order to make proper arguments against the reference, the Applicants must cite specific claimed limitations that **Stimac** fails to anticipate, suggest or render obvious.

36. In response to the Applicants' argument that the **Stimac** reference fails to teach the accounting module as claimed in amended claims 1, 10 and 11, the examiner respectfully responds that the rejections of these claims have been changed to incorporate the **Taylor** reference, teaching the claimed accounting module.

37. In response to the Applicants' argument that the accounting system of Taylor is different from that claimed, because "...the present invention includes...an accounting system capable of tracking the cost of hiring and reducing the cost through better interaction of the different components (a) through (g)", the examiner respectfully responds that not only is such a limitation not in the claim, but neither does it appear in the specification. In fact, the only mention of an accounting system in the entire as-filed application was that in claim 2, "...further comprising an accounting system connected to said process controller." There is no disclosure of an accounting system in the specification at all. Given these facts, the examiner is free to interpret the claimed accounting system broadly.

38. In response to the Applicants' argument that Regarding the Applicants' argument that the combination of the **Stimac** reference and the **Taylor** reference is the result of impermissible

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hindsight, the examiner respectfully disagrees and reiterates the response to this argument from the final rejection mailed on 18 October 2004.

The **Stimac** reference teaches a system for managing the hiring process, including a system for soliciting and collecting resumes from perspective hires. The **Taylor** reference teaches a similar system for exchanging information between job applicants and employers, and including an accounting system to manage fees to be charged to the employers for access to the system.

The rejection of record provides ample motivation for incorporating an accounting system into the system of **Stimac**, said motivation provided by the **Taylor** reference itself.

From MPEP § 2143.01[R-2]:

"There are three possible sources for a motivation to combine references: the nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the art." *In re Rowffet*, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457-58 (Fed. Cir. 1998) (The combination of the references taught every element of the claimed invention, however without a motivation to combine, a rejection based on a prima facie case of obvious was held improper.). The level of skill in the art cannot be relied upon to provide the suggestion to combine references. *Al-Site Corp. v. VSI Int 'l Inc.*, 174 F.3d 1308, 50 USPQ2d 1161 (Fed. Cir. 1999).

"In determining the propriety of the Patent Office case for obviousness in the first instance, it is necessary to ascertain whether or not the reference teachings would appear to be sufficient for one of ordinary skill in the relevant art having the reference before him to make the proposed substitution, combination, or other modification." *In re Linter*, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972).

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Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. "The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art." *In re Kotzab*, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000). See also *In re Lee*, 277 F.3d 1338, 1342-44, 61 USPQ2d 1430, 1433-34 (Fed. Cir. 2002) (discussing the importance of relying on objective evidence and making specific factual findings with respect to the motivation to combine references); *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

In Ruiz v A.B. Chance Co., 357 F.3d 1270, 69 USPQ2d 1686 (Fed. Cir. 2004), the patent claimed underpinning a slumping building foundation using a screw anchor attached to the foundation by a metal bracket. One prior art reference taught a screw anchor with a concrete bracket, and a second prior art reference disclosed a pier anchor with a metal bracket. The court found motivation to combine the references to arrive at the claimed invention in the "nature of the problem to be solved" because each reference was directed "to precisely the same problem of underpinning slumping foundations." *Id.* at 1276, 69 USPQ2d at 1690. The court also rejected the notion that "an express written motivation to combine must appear in prior art references..." *Id.* at 1276, 69 USPQ2d at 1690.

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The claim rejections based upon the combination of the **Stimac** and **Taylor** references are maintained by the examiner.

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Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Luke S. Wassum whose telephone number is 571-272-4119. The examiner can normally be reached on Monday-Friday 8:30-5:30, alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John E. Breene can be reached on 571-272-4107. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

In addition, INFORMAL or DRAFT communications may be faxed directly to the examiner at 571-273-4119.

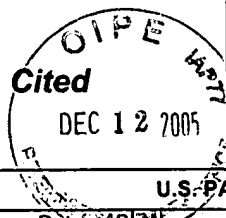
Customer Service for Tech Center 2100 can be reached during regular business hours at (571) 272-2100, or fax (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Luke S. Wassum
Primary Examiner
Art Unit 2167

lsW
18 February 2005

Notice of References Cited

Application/Control No.

09/932,004

Applicant(s)/Patent Under
Reexamination
NEECE ET AL.

Examiner

Luke S. Wassum

Art Unit

2167

Page 1 of 1

U.S. PATENT DOCUMENTS

*		Document Number Country Code-Number-Kind Code	Date MM-YYYY	Name	Classification
	A	US-			
	B	US-			
	C	US-			
	D	US-			
	E	US-			
	F	US-			
	G	US-			
	H	US-			
	I	US-			
	J	US-			
	K	US-			
	L	US-			
	M	US-			

FOREIGN PATENT DOCUMENTS

*		Document Number Country Code-Number-Kind Code	Date MM-YYYY	Country	Name	Classification
	N					
	O					
	P					
	Q					
	R					
	S					
	T					

NON-PATENT DOCUMENTS

*		Include as applicable: Author, Title Date, Publisher, Edition or Volume, Pertinent Pages)
	U	Microsoft "Computer Dictionary Third Edition", Redmond:Microsoft Press, definitions of the terms 'field' and 'key field', 1997, pp 194 and 273.
	V	
	W	
	X	

*A copy of this reference is not being furnished with this Office action. (See MPEP § 707.05(a).)
Dates in MM-YYYY format are publication dates. Classifications may be US or foreign.



Customer No 42131

Docket No. 144.002

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Michael Neece et al

Serial No.: 09/932,004

Art Unit: 2177

Filed: August 17, 2001

Examiner: WASSUM, Luke S.

For: Systems and Methods For Intelligent Hiring

Commissioner for Patents

Alexandria, VA 22313-1450

AMENDMENT Under 37 CFR 1.112

Sir:

In response to the Office Action dated October 18, 2005 Applicant files this response and amendments, and a Petition for Extension of time for two months with appropriate fees.

Exh 2

IN THE CLAIMS

1. (currently amended) A computer readable medium of instructions configured as a multiple database information exchange and hiring system used in network operations, said system comprising:

a first database of information pertaining to a job opening or demand-side needs of a company, stored in electronically readable memory;

a second database of information on positions, interview teams, questions to evaluate candidates by skills, experience or personal profiles related to the job opening;

a server and communication port suitable for transmitting and receiving data from the first data base, instructions from the second database or coordinating the communication between the interviewers in the form of electrical signals to and from remote computers;

a database management system for creating and revising records of said first database and said second database connected to said electronically readable memory responsive to the remote computers;

an interactive database query engine connected to said memory, said query engine configured to permit a plurality of searches and appended searches by a plurality of users, including position owner, position contributor or an interviewer to produce current results that are coordinated and communicated between all users; and

a process controller connected to said interactive database and an accounting system that facilitates accounts management, said process controller facilitating an intelligent, collaborative and coordinated solution to demand-side job recruiting,

wherein said interactive database is a company database containing human resource and hiring records.

2. (cancelled)

3. (original) The computer readable medium of instructions according to claim 1, further comprising a security means connected to said process controller.

4. (currently amended) The computer readable medium of instructions according to claim 1, wherein the human resources and hiring records contain a plurality of search key fields, each of said key fields selected from a group consisting of a selection criteria, data on coordination of interviews, data on preparation of questions, data on feedback from interviewers and data on candidate evaluations.

5. (original) The computer readable medium of instructions according to claim 1, further comprising a database of instructions pertaining to training of users.

6. (original) The computer readable medium of instructions according to claim 4, wherein said interactive database query engine includes means for searching key fields of a database for the satisfaction of one or more conditions, and means for reporting and exchanging all variables in said search key fields of records which satisfy said one or more conditions.

7. (currently amended) The computer readable medium of instructions according to claim ~~4~~ 6, wherein said means for searching key fields of a data base include at least one of : a customer administration key, an interview key, a report key, an options key, a search key or a tutorial key.

8. (previously presented) The computer readable medium of instructions

according to claim 5, further comprising means for organizing the hiring process by coordinating the exchange of information at every step of the hiring process between different levels of users assigned for the hiring process, wherein the hiring process includes the steps of

- defining a position,
- coordinating the interview teams,
- organizing the interview questions,
- evaluating the candidates, and
- reviewing the candidate evaluations.

9. (previously presented) The computer readable medium of instructions according to claim 7, further comprising means to restrict entries in at least one of said means of searching key fields of a database to a predetermined set of entries.

10. (currently amended) A computer software system provided to execute hiring practices intelligently, said system comprising:

- a first database of information pertaining to job openings and demand-side needs of a company;

- a second database of positions information, interview teams and questions to evaluate candidates by skills, experience or personal profiles;

- a third database of company records compiled by the human resources department, said third database containing user data records, administration data records, option data records , search data records or tutorial data records;

- a database management system connected to the software linking it to multiple databases and multiple remote computers ;

an interactive database query engine connected to said data base management system configured to permit a plurality of searches and appended searches by a plurality of users, including position owner, position contributor or an interviewer to produce current results that are coordinated and communicated between all users and

a process controller connected to ~~said a database~~ data management system and an accounting system to facilitate accounts management and collaborative and coordinated solution to demand-side process of recruiting.

11. (previously presented) A method of hiring personnel intelligently, said method comprising the steps of:
 - creating a computer readable file including information pertaining to job openings and needs of a company,
 - uploading a portion of the computer readable file connected to an accounting system to facilitate accounts management, via a process controller to a medium accessible via a computer network with information on interview teams, questions to evaluate candidates by skill, experience and personal profiles and instructions for interviewers;
 - searching information in the uploaded portion of the computer readable file for the presence of information corresponding to information requested by a user;
 - accessing the information requested from relevant databases in the network;
 - assigning tasks, coordinating interview processes and managing interview evaluations from teams; and

permitting the user to send said information via the computer network to another computer readable file located in the same hiring environment, to exchange said information with another user and to facilitate creating a coordinated summary of recommendations for hiring.

12. (cancelled)

REMARKS

Claims 1,4, 7, 10 and 11 are amended. Claims 2 and 12 are cancelled. Claims 1, and 3 through 11 are under consideration. Reconsideration of all amended and original claims is respectfully requested.

Claim Objections

Claim 10 was objected to. Claim 10 has been amended to state “said database management system”.

Rejection Under 35 U.S.C. § 112 Rejection

Claims 4,6,7, 9, 10, and 12 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter of the invention.

In response, claim 4 is amended to delete “key field” and use instead “fields”.

Claim 7 was amended to depend on claim 6.

Claim 10 was amended to delete in the last limitation, “said data” and replace it with “a database “.

Claim 12 is cancelled.

In summary, the above amendments correct all of the deficiencies, and therefore, above rejection of claims 4, 6, 7, 9 and 10 should be withdrawn.

35 U.S.C. § 103 (a)

Applicants submit that the subject matter of the various claims was commonly owned at the time of the invention covered, in considering patentability under section 103(a).

In paragraphs 20-21, *the Action states Claim 1 and 3-12 are rejected over Stimac (US Appl. No 2003/0071852) in view of Taylor (U.S. Patent 5,832,497)*

Regarding claim 1 the Action states that Stimac teaches a computer readable medium of instructions configured as a multiple database information exchange and hiring system....

Regarding claim 11 the Action rejects claim 11 because Stimac teaches a method of hiring personnel intelligently.

However, the Action admits that Stimac does not explicitly teach a computer readable medium further comprising an accounting system connected to said process controller.

The Action states: Taylor, however, teaches an accounting system connected to said process controller (col 2, line 13; see also col 6, lines 47-57). It would have been obvious to one of ordinary skill in the art at the time of the invention to include an accounting system, since this would allow the operator of the system to charge a fee for its use (see col 6, lines 47-57).

In paragraph 38, the Action states that the rejection of record provides ample motivation for incorporating an accounting system into the system of Stimac, said motivation provided by Taylor reference itself.

In paragraph 37, the Action states that *“There is no disclosure of an accounting system in the specification at all. Given these facts, the examiner is free to interpret the claimed accounting system broadly.*

In response, applicants disagree. This is because there is ample disclosure of an accounting system in applicants specification, e.g.,

- 1) Page 1, lines 17- to page 2, line 8.
- 2) Page 10, line 14 to page 11, line 2- Description of Figure 3 that describes the duties of Intell-Hire Administrator in reference to Account Creation, Account Edit, Merge/Unmerge account.
- 3) Page 11, lines 10-20, Description of Figure 5 describing the Management of account.
- 4) Figure 3 describing Account Creation, Account Edit, Account Merge/Unmerge.
- 5) Figure 5 describing Management of Account.

Therefore, in view of the above facts, the examiner is not free to interpret the claimed accounting system broadly.

MPEP 2143.01 [R-2] cited in the Action, states:

“There are three possible sources for a motivation to combine references: the nature of the problem to be solved, the teachings of the prior art, and the knowledge of the persons of ordinary skill in the art” In re Rouffet, 149 F 3d 1350, 1357, 47 USPQ 2d 1453, 1457-58 (Fed Cir 1998) (The combination of the references taught every element of the claimed invention, however, without a motivation to combine, a rejection based on a prima facie case of obviousness was held improper). The level of skill in the art cannot

be relied upon to provide the suggestion to combine references. Al-Site Corp v VSI Intel Inc., 174 F3d 1308, 50 USPQ 2d 1161 (Fed Cir 1999).

Applying the above case law, the nature of the problem to be solved in the present invention and in the cited references is clearly NOT the same. The motivation to control costs and facilitating accounting management (of the present invention) is not present in Taylor. Therefore, pursuant to In re Rouffet, the above rejection was improper.

The examiner states that the limitation of the accounting system was not in the claims. In response applicants disagree. However, Claims 1, 7, 10 and 11 have been amended to include the limitation of the accounting system "facilitating the accounts management". As a matter of law, the above rejection cannot be sustained.

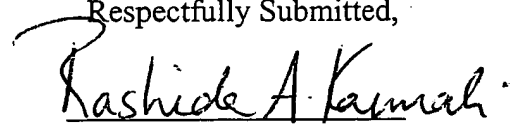
"When the motivation to combine the teachings of the references is not immediately apparent, it is the duty of the examiner to explain why the combination of the teachings is proper". Ex parte Skinner, 2 USPQ 1788 (Bd. Pat. App. & Inter. 1986).

In paragraphs 24-31, the Action has rejected Claims 3 (#24), 4 (#25), 5 (#26), 6(#27), 7(#28), 8(#29), 9 (#30), and 12 (#31).

In response, applicants disagree. Since the above claims 3-9, are dependent on claim 1, the above response for claim 1 applies to them. Claim 12 has been cancelled.

Therefore, as a matter of fact and law, there is no basis to sustain the rejection of any of the claims under consideration 1, 3-11, as being obvious over Stimac in view of Taylor. This rejection should be withdrawn.

Respectfully Submitted,



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Date: June 22, 2005

CERTIFICATE OF EXPRESS MAILING

I hereby certify that this correspondence is transmitted by Express Class No. ER
168667886 US under 37 C.F.R. 1.10 on January 18, 2005 addressed to: Commissioner
for Patents, Alexandria, VA 22313-1450.

Rashida A. Karmali
Attorney for Applicants

Rashida A. Karmali
Signature
6/22/05



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/932,004	08/17/2001	Michael Neece	144.002	4173

7590 08/17/2005
Rashida A. Karmali, PhD
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BY:

EXAMINER	
WASSUM, LUKE S	
ART UNIT	PAPER NUMBER
2167	

DATE MAILED: 08/17/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Exh 3.

Office Action Summary

Application No.

09/932,004

Applicant(s)

NEECE ET AL

Examiner

Luke S. Wassum

Art Unit

2167

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 June 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 3-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 August 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
- Paper No(s)/Mail Date _____.

- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

1. The Applicants' amendment, filed 22 June 2005, has been received, entered into the record, and considered.

2. As a result of the amendment, claims 1, 4, 7, 10 and 11 have been amended, and claim 12 has been canceled. Claims 1 and 3-11 remain pending in the application.

The Invention

3. The claimed invention is a system for facilitating the hiring process, including searchable databases for job openings and positions.

Claim Objections

4. In view of the amendment to claim 10, the examiner withdraws the pending objection to this claim.

Claim Rejections - 35 USC § 112

5. In view of the amendments to the claims, the examiner withdraws all pending claim rejections under 35 U.S.C. § 112.

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Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

8. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

9. Claims 1 and 3-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Stimac** (U.S. Patent Application Publication 2003/0071852) in view of **Taylor** (U.S. Patent 5,832,497).

10. Regarding claim 1, **Stimac** teaches a computer readable medium of instructions configured as a multiple database information exchange and hiring system used in network operations substantially as claimed, said system comprising:

- a) a first database of information pertaining to a job opening or demand-side needs of a company, stored in electronically readable memory (see disclosure of the additional information, such as position contact information and location, that constitutes the claimed job opening, paragraphs [0128] through [0130]; see also Figure 30A);
- b) a second database of information on positions, interview teams, questions to evaluate candidates by skills, experience or personal profiles related to the job opening (see disclosure of positions information at paragraphs [0127] and [0128] and in Figure 30A; see also disclosure of information on interview teams, paragraphs [0157] and [0158] and also Figures 62, 63 and 64; see also disclosure of information on questions to evaluate candidates, paragraph [0159] and Figures 65, 66 and 66A);
- c) a server and communication port suitable for transmitting and receiving data from the first database, instructions from the second database or coordinating the communication between interviewers in the form of electrical signals to and from remote computers (see disclosure that the system allows information to be electronically shared and portions of the recruitment process to be handled by different recruiters throughout the world, paragraphs [0009] through [0011]);

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- d) a database management system for creating and revising records of said first database and said second database connected to said electrically readable memory responsive to the remote computers (see paragraphs [0128] through [0130]);
- e) an interactive database query engine connected to said memory, said query engine configured to permit a plurality of searches and appended searches by a plurality of users, including position owner, position contributor or an interviewer to produce current results that are coordinated and communicated between all users (see paragraphs [0126] and [0127], and also Figure 29; see also disclosure that various information can be shared globally, paragraphs [0009] through [0011]); and
- f) a process controller connected to said interactive database query engine, said process controller facilitating an intelligent, collaborative and coordinated solution to demand-side job recruiting, wherein said interactive database query engine is a company database containing human resource and hiring records (see disclosure of a method and system for managing the recruitment process and including a database of human resource information, paragraphs [0103] through [0108]).

Stimac does not explicitly teach a computer readable medium further comprising an accounting system that facilitates accounts management connected to said process controller.

Taylor, however, teaches an accounting system that facilitates accounts management connected to said process controller (see col. 2, line 13; see also col. 6, lines 47-57).

It would have been obvious to one of ordinary skill in the art at the time of the invention to include an accounting system that facilitates accounts management, since this would allow the operator of the system to charge a fee for its use (see col. 6, lines 47-57).

11. Regarding claim 10, **Stimac** teaches a computer software system provided to execute hiring practices intelligently substantially as claimed, said system comprising:

- a) a first database of information pertaining to job openings and demand-side needs of a company (see disclosure of the additional information, such as position contact information and location, that constitutes the claimed job opening, paragraphs [0128] through [0130]; see also Figure 30A);
- b) a second database of positions information, interview teams and questions to evaluate candidates by skills, experience and personal profiles (see disclosure of positions information at paragraphs [0127] and [0128] and in Figure 30A; see also disclosure of information on interview teams, paragraphs [0157] and [0158] and also Figures 62, 63 and 64; see also disclosure of information on questions to evaluate candidates, paragraph [0159] and Figures 65, 66 and 66A);
- c) a third database of company records compiled by the human resources department, said third database containing user data records, administration data records, option data records, search data records or tutorial data records (see disclosure of a method and system for managing the recruitment process and including a database of human resource information, paragraphs [0103] through [0108]);

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- d) a database management system connected to the software linking it to multiple databases and multiple remote controllers (the claimed database management system being inherent in a system having the wide range and types of data of that taught in the reference; see disclosure that the system can be used to share data worldwide, thus requiring multiple remote controllers, paragraphs [0009] through [0011]);
- e) an interactive database query engine connected to said database management system configured to permit a plurality of searches and appended searches by a plurality of users, including position owner, position contributor or an interviewer to produce current results that are coordinated and communicated between all users (see paragraphs [0126] and [0127], and also Figure 29; see also disclosure that various information can be shared globally, paragraphs [0009] through [0011]); and
- f) a process controller connected to said database management system to facilitate collaborative and coordinated solution to demand-side process of recruiting (see disclosure of a method and system for managing the recruitment process and including a database of human resource information, paragraphs [0103] through [0108]).

Stimac does not explicitly teach a computer readable medium further comprising an accounting system that facilitates accounts management connected to said process controller.

Taylor, however, teaches an accounting system that facilitates accounts management connected to said process controller (see col. 2, line 13; see also col. 6, lines 47-57).

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It would have been obvious to one of ordinary skill in the art at the time of the invention to include an accounting system that facilitates accounts management, since this would allow the operator of the system to charge a fee for its use (see col. 6, lines 47-57).

12. Regarding claim 11, **Stimac** teaches a method of hiring personnel intelligently substantially as claimed, said method comprising the steps of:

- a) creating a computer readable file including information pertaining to job openings and needs of a company (see disclosure of the additional information, such as position contact information and location, that constitutes the claimed job opening, paragraphs [0128] through [0130]; see also Figure 30A);
- b) uploading a portion of the computer readable file to a medium accessible via a computer network with information on interview teams, questions to evaluate candidates by skill, experience and personal profiles and instructions for interviewers (see disclosure that the system can be used to share data worldwide, paragraphs [0009] through [0011], and that the preferred mechanism for data sharing is the Internet, paragraph [0100]; see also disclosure of positions information at paragraphs [0127] and [0128] and in Figure 30A; see also disclosure of information on interview teams, paragraphs [0157] and [0158] and also Figures 62, 63 and 64; see also disclosure of information on questions to evaluate candidates, paragraph [0159] and Figures 65, 66 and 66A; see disclosure of instructions for interviewers, paragraph [0159] and Figure 67);
- c) searching information in the uploaded portion of the computer readable file for the presence of information corresponding to information requested by a user (see

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disclosure of different search/retrieval functionality available, paragraphs [0126] and [0138]);

- d) accessing the information requested from relevant database in the network (see disclosure of different search/retrieval functionality available, paragraphs [0126] and [0138]);
- e) assigning tasks, coordinating interview processes and managing interview evaluations from teams (see disclosure of the assigning tasks and coordinating the interview process, paragraphs [0157] through [0159] and Figures 62, 63 and 64; see also managing interview evaluations, paragraph [0160] and Figures 68 and 69); and
- f) permitting the user to send said information via the computer network to another computer readable file located in the same hiring environment, to exchange said information with another user and to facilitate creating a coordinated summary of recommendations for hiring (see disclosure that the system can be used to share data worldwide, paragraphs [0009] through [0011]).

Stimac does not explicitly teach a computer readable medium further comprising an accounting system that facilitates accounts management connected to said process controller.

Taylor, however, teaches an accounting system that facilitates accounts management connected to said process controller (see col. 2, line 13; see also col. 6, lines 47-57).

It would have been obvious to one of ordinary skill in the art at the time of the invention to include an accounting system that facilitates accounts management, since this would allow the operator of the system to charge a fee for its use (see col. 6, lines 47-57).

13. Regarding claim 3, **Stimac** additionally teaches a computer readable medium further comprising a security means connected to said process controller (see userid/password access control, paragraph [0101]).

14. Regarding claim 4, **Stimac** additionally teaches a computer readable medium wherein the human resources records contain a plurality of search fields, each of said fields consisting of a search criteria, data on coordination of interviews, data on preparation of questions, data on feedback from interviewers or data on candidate evaluations (see paragraphs [[0109] through [0111], [0128] through [0135]; see also Figures 62, 63, 64, 68 and 69).

15. Regarding claim 5, **Stimac** additionally teaches a computer readable medium further comprising a database of instructions pertaining to training of users (see disclosure of interview tips which provides a helpful guide to interviewing, paragraph [0159] and Figure 67).

16. Regarding claim 6, **Stimac** additionally teaches a computer readable medium wherein said interactive database query engine includes means for searching key fields of a database for the satisfaction of one or more conditions, and means for reporting and exchanging all variables in said search key fields of records which satisfy said one or more conditions (see disclosure of different search/retrieval functionality available, paragraphs [0126] and [0138]; see also disclosure that the system can be used to share data worldwide, paragraphs [0009] through [0011]).

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17. Regarding claim 7, **Stimac** additionally teaches a computer readable medium wherein said means for searching key fields of a database include at least one of a customer administration key, an interview key, a report key, an options key, a search key or a tutorial key (see administration screen in paragraph [0102], and interview in paragraphs [0113] and [0131] through [0134]).

18. Regarding claim 8, **Stimac** additionally teaches a computer readable medium further comprising means for organizing the hiring process by coordinating the exchange of information at every step of the hiring process between different levels of users assigned for the hiring process (see disclosure that the system can be used to share data worldwide, paragraphs [0009] through [0011]), wherein the hiring process includes the steps of defining a position (see disclosure of the additional information, such as position contact information and location, that constitutes the claimed job opening, paragraphs [0128] through [0130]; see also Figure 30A), coordinating the interview teams (see disclosure of the assigning tasks and coordinating the interview process, paragraphs [0157] through [0159] and Figures 62, 63 and 64), organizing the interview questions (see disclosure of information on questions to evaluate candidates, paragraph [0159] and Figures 65, 66 and 66A; see also paragraph [0161] and Figure 71), evaluating the candidates (see managing interview evaluations, paragraph [0160] and Figures 68 and 69), and reviewing the candidate evaluations (see managing interview evaluations, paragraph [0160] and Figures 68 and 69).

19. Regarding claim 9, **Stimac** additionally teaches a computer readable medium further comprising means to restrict entries in at least one of said means of searching key fields of a database to a predetermined set of entries (see disclosure of the use of drop-down menus, effectively

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restricting entries in the search key fields, paragraphs [0103], [0109], [0117], [0128], [0129] and [0161]).

Response to Arguments

20. Applicant's arguments filed 22 June 2005 have been fully considered but they are not persuasive.

21. Regarding the Applicants' argument that the examiner is not free to interpret the "accounting system" limitation broadly, the examiner respectfully disagrees.

The Applicants have pointed out the disclosure in the specification of an accounting system. However, these disclosures merely disclose functionality regarding the management of accounts, such as account creation and editing. The examiner points out that any accounting system (as that term is commonly accepted) would inherently have functionality such as account creation and editing. For this reason, (and also because such functionality does not appear in the claims), the accounting system as disclosed in the **Taylor** reference would serve to anticipate that accounting system as claimed by the Applicants.

22. Regarding the Applicants' argument that the newly added limitation that the accounting system facilitates accounts management distinguishes over the accounting system taught by the **Taylor** reference, the examiner points out that *any* accounting system, by definition, would facilitate accounts management; accounts management is the purpose of an accounting system.

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23. Regarding the Applicants' argument that there is no motivation to combine the **Taylor** reference with the **Stimac** reference, the examiner respectfully disagrees.

First of all, the examiner has supplied motivation to incorporate the feature of an accounting system that comes straight from the prior art reference. At col. 6, lines 47-57, **Taylor** teaches that an accounting system can be used to impose charges on the users of the system. Particularly in light of the fact that the **Stimac** reference teaches the use of their system by job recruiting/placement firms (e.g., paragraphs [0005], [0006], [0137], et seq.), an ordinary artisan would have found it obvious to incorporate an accounting system in order to impose charges on users of the system.

Given this fact, the examiner then points out that the motivation as stated in the rejection of record has been found in the prior art, and not in the nature of the problem to be solved (as argued by the Applicants).

However, the Applicants have taken the fact that combinations can be properly motivated by the nature of the problem to be solved, and then argued that the nature of the problem to be solved by their own invention is different than that of the **Taylor** reference. This fact is irrelevant. Proper motivation to combine references (under the 'nature of the problem to be solved' doctrine) requires that the nature of the problem to be solved of the two references being combined be the same as each other, not the same as the invention.

Regardless of the Applicants' arguments, the nature of the problem to be solved by both the **Stimac** and **Taylor** references (and also by the Applicants' invention) is the efficient recruitment and procurement of qualified job applicants, and as such, under the 'nature of the problem to be solved' doctrine, an ordinary artisan would in fact have been motivated to borrow features of one of the references and incorporate them into the other, further supporting the incorporation of the accounting system of **Taylor** with the system of **Stimac**.

24. The examiner maintains the rejections of record.

Conclusion

25. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Luke S. Wassum whose telephone number is 571-272-4119. The examiner can normally be reached on Monday-Friday 8:30-5:30, alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John E. Breene can be reached on 571-272-4107. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

In addition, INFORMAL or DRAFT communications may be faxed directly to the examiner at 571-273-4119. Such communications must be clearly marked as INFORMAL, DRAFT or UNOFFICIAL.

Customer Service for Tech Center 2100 can be reached during regular business hours at (571) 272-2100, or fax (571) 273-2100.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Luke S. Wassum
Primary Examiner
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